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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/647,235	08/26/2003	Ryoji Watanabe	116939	1746
25944	7590	03/22/2007	EXAMINER	
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			PAHNG, JASON Y	
			ART UNIT	PAPER NUMBER
			3725	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/22/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

88

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/647,235	WATANABE ET AL.	
	Examiner Jason Y. Pahng	Art Unit 3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 05 March 2007.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1,2,4-9,11,13,14 and 16-19 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) 16 and 17 is/are allowed.

6) Claim(s) 1,2,4-9,11,13,14,18 and 19 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date _____	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 5, 2007 has been entered.

### ***Claim Objections***

The amendment overcomes the claim objections made in the last Office action.

### ***Claim Rejections - 35 USC § 112***

The amendment overcomes the claim rejections under 35 U.S.C. 112 made in the last Office action.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 2, 5, 6, 11, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang in view of Bennett et al. (US 6,758,392) and Colgate, Jr. (US 4,547,002).

With regard to claims 1, 2, 5, and 19, Chang discloses substantially all of the claimed structure including:

1. a transport path or an insertion port (12);
1. a destroy process unit (1) that destroys data stored in an electronic data storage device of an image display member or a credit card;
2. a shredding process unit (20, 30) that shreds the image display member or a credit card; and
3. a sensing unit (14).

Chang discloses a sensing unit (14) to detect an image display unit, but does not disclose detecting an electronic data storage device or a control unit. In a closely related art, disclose detecting an electronic data storage device. In a closely related art, Bennett discloses a credit card destroy process unit with a sensor and controller capable of detecting an electronic data storage device in order to control the destruction (column 1, lines 28-39 and 62-66). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to provide Chang with a sensor and controller capable of detecting an electronic data storage device in order to control the destruction, as taught by Bennett. Although Chang does not explicitly disclose a display member comprising paper, Colgate is referenced to show that credit card may be made of either plastic or paper.

With regard to claim 6, Chang discloses an insertion port (12) wherein the destroy process unit (1 and including 15) is disposed closer to the insertion port (12) than the shredding process unit (20, 30).

With regard to claim 11, Chang discloses a sensor (13) which senses the presence of an image display member in order to control at least the shredding process.

Claims 4, 7-9, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang (US 6,676,050) in view of Bennett et al. (US 6,758,392) and Colgate, Jr. (US 4,547,002) as applied above, further in view of Abramson (US 4,931,770) and Matsumoto et al. (US 4,879,724). Claim 4 calls for at least one of electric or magnetic application, and claim 9 calls for electromagnetic wave to overwrite another data to destroy data. In a closely related art, Matsumoto discloses a rewritable optical disk memory system (column 1, lines 21-23) and therefore inherently discloses overwriting another data to in order to destroy data. In another closely related art, Abramson teaches that using abrasive, cutting, chemical, magnetic, or other suitable component adapted to destroy information on a disc is well known in the art (column 2, lines 30-32). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to provide Chang (as modified) with a rewritable optical disk memory system in order to destroy data in a disc, as such is well known in the art and taught by Matsumoto and Abramson.

With regard to claims 7 and 18, the modified device of Chang is capable of shredding or applying electric field. Whether the image display unit is shredded first and electric field is applied later or electric field is applied first and shredded later is not

relevant. How an apparatus is used is considered in a process claim and is not germane to the patentability of an apparatus claim.

Claim 8 does not add any further limitation to claim 4. The use of electric field claimed in claim 4 would inherently include application of voltage.

Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang (US 6,676,050) in view of Bennett et al. (US 6,758,392) and Colgate, Jr. (US 4,547,002) as applied above, further in view of Bley (US 6,038,012). Claims 13 and 14 call for the electronic data storage device to comprise an IC chip. In a closely related art pertinent to the problem, Bley discloses an electronic data storage device comprising an IC chip (column 1, lines 56-58) in order to make a card to be a smart card. Therefore, it would have been obvious to one skilled in the art at the time the invention was made to provide Chang (as modified) with an electronic data storage device comprising an IC chip in order to make his card to be a smart card, as taught by Bley.

#### ***Allowable Subject Matter***

Claims 16 and 17 are allowed.

#### ***Response to Arguments***

Applicant's arguments filed March 5, 2007 have been fully considered but they are not persuasive.

Applicant argues that according to the Chang reference, Chang's paper shredder (1) cannot be provided along the compact disc inlet (12). However, this is not germane

to the patentability of claim 1. The claim merely calls for a data destroy unit to be provided along a transport path. Chang, in fact, discloses a data destroy unit (20, 30) provided along a transport path (12).

Applicant also argues that Chang does not comprise a single inlet port because Chang discloses two inlet ports. This is not persuasive. Chang specifically comprises a single inlet port precisely because Chang discloses two inlet ports.

It is noted that Applicant's claim rejections have not been modified because no new subject matter was introduced. The rejection of claim 19 is merely added on to the heading of rejection of claim 1. Therefore, this Office action is made Final even though it is a first action in this case.

### ***Conclusion***

This is a request for continued examination of applicant's earlier Application. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Y. Pahng whose telephone number is 571 272 4522. The examiner can normally be reached on 9:30 AM - 8:00 PM, Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Banks H. Derris can be reached on 571 272 4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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